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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.		
10/731,055	12/09/2003	Frank R. Overstreet	2002-020	6723		
54472	7590	01/28/2009	EXAMINER			
COATS & BENNETT/SONY ERICSSON 1400 CRESCENT GREEN SUITE 300 CARY, NC 27518				BEMBEN, RICHARD M		
ART UNIT		PAPER NUMBER				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## DETAILED ACTION

### ***Affidavit/Declaration - 37 CFR 1.131***

1. The Declarations of Ivan Nelson Wakefield filed on 8 July 2008 and 13 January 2009 under 37 CFR 1.131 have been considered but are ineffective to overcome the Takahashi (US Pub. No. 2004/0004671) reference.

2. The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Takahashi reference to either a constructive reduction to practice or an actual reduction to practice. Under 37 CFR 1.131, the critical period in which diligence must be shown begins just prior to the effective date of the reference or activity and ends with the date of a reduction to practice, either actual or constructive (i.e., filing a United States patent application). **MPEP 715.07(a)**. The date of reduction to practice of the Takahashi reference (i.e., US filing date) is 24 June 2003. Exhibit 2 [of the Declaration filed 8 July 2008] effectively shows conception of the claimed invention not later than 12 March 2003. However, regarding numbered paragraphs 5 and 6 of the Declaration filed 8 July 2008 and numbered paragraphs 2-7 of the Declaration filed 13 January 2009, diligence from just prior to 24 June 2003 has not been shown because (1) it is unclear when the internal review board reviewed the Invention Disclosure and (2) the “request to file” letter was prepared on or about 7 July 2003, which is not just prior to 24 June 2003.

Applicant argues that the due diligence requirement has been satisfied because:

The employees that perform the formal internal review process, however, are engaged primarily with other aspects of the day-to-day business of the company. That is, they have their primary job functions to perform. Because the employees review invention disclosures while still performing their daily duties, as well as the

fact that there are multiple invention disclosures that require review, the formal review process takes about three-four months from the time a disclosure is submitted until the request to file letter is prepared and sent to outside counsel. This is not an unreasonable amount of time for a company such as Sony Ericsson to receive an invention disclosure from an employee, and have other employees evaluate the invention for its technical and business merits.

**Applicant's Remarks filed 13 January 2009, page 2.**

However, the Examiner maintains the position that the Applicant has not satisfied the due diligence requirement. **MPEP 2138.06 [R-1]** discusses "Reasonable Diligence". A relevant portion of that section states:

The period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses. *Rebstock v. Flouret*, 191 USPQ 342, 345 (Bd. Pat. Inter. 1975); *Rieser v. Williams*, 225 F.2d 419, 423, 118 USPQ 96, 100 (CCPA 1958) (Being last to reduce to practice, party cannot prevail unless he has shown that he was first to conceive and that he exercised reasonable diligence during the critical period from just prior to opponent's entry into the field); *Griffith v. Kanamaru*, 816 F.2d 624, 2 USPQ2d 1361 (Fed. Cir. 1987) (Court generally reviewed cases on excuses for inactivity including vacation extended by ill health and daily job demands, and held lack of university funding and personnel are not acceptable excuses.); *Litchfield v. Eigen*, 535 F.2d 72, 190 USPQ 113 (CCPA 1976) (budgetary limits and availability of animals for testing not sufficiently described); *Morway v. Bondi*, 203 F.2d 741, 749, 97 USPQ 318, 323 (CCPA 1953) (voluntarily laying aside inventive concept in pursuit of other projects is generally not an acceptable excuse although there may be circumstances creating exceptions); *Anderson v. Crowther*, 152 USPQ 504, 512 (Bd. Pat. Inter. 1965) (preparation of routine periodic reports covering all accomplishments of the laboratory insufficient to show diligence)...

**MPEP 2138.06 [R-1] under the heading THE ENTIRE PERIOD DURING WHICH DILIGENCE IS REQUIRED MUST BE ACCOUNTED FOR BY EITHER AFFIRMATIVE ACTS OR ACCEPTABLE EXCUSES.** It is the Examiner's position that Applicant's situation is most similar to *Griffith* (lack of personnel) and/or *Morway* and therefore does not constitute an acceptable excuse.

Because the Applicant has not shown due diligence from just prior to 24 June 2003, the date of reduction to practice of the Takahashi reference, the claim rejections in Final Office Action dated 14 October 2008 are maintained.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RICHARD M. BEMBEN whose telephone number is (571)272-7634. The examiner can normally be reached on 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Ometz can be reached on (571) 272-7593. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David L. Ometz/  
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RMB